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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,138

10/14/2004

Kouhei Fujita

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25944

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11/15/2007

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

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EXAMINER

FORD, JOHN K

ART UNIT

PAPER NUMBER

3744

MAIL DATE

DELIVERY MODE

11/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/511,138	Applicant(s) FUJITA ET AL.	
	Examiner John K. Ford	Art Unit 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/11/07
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4, 10, 13, 16, 21, 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-13, 14-15, 17-20, 22-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14/04/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 14/10/2004 & 04/27/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's election of the species of Figures 2-6, with traverse, is acknowledged. Applicant has identified claims 1-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 as being readable on the elected species.

Applicant's traverse based on the assertion that the office action did not adequately show that all of the elements of claim 1 were known in the prior art is unpersuasive. The EPO and JPO search reports show numerous "X" documents (i.e. 102(b) references) on claim 1. It is submitted that only by engaging in willful blindness could one maintain that all of the elements of claim 1 were not known in the prior art. Moreover there is no requirement as to precisely what the showing by the examiner has to be, and as far as the examiner is concerned the foreign search reports are perfectly adequate to show that claim 1 is unpatentable. Applicant's traverse is unpersuasive and the election requirement is made final.

Pursuant to MPEP 2001.06(a), the examiner is requiring updates in each of applicant's forthcoming responses, as to the status of the claims being pursued in the EPO and JPO prosecutions. Copies in English of the allowed and rejected claims in each of those prosecutions as they progress is required as well as translations of the corresponding EPO and JPO office actions. This will allow the undersigned to improve the quality of the examination of the current application.

It was also a waste of the examiner's limited search time to spend time finding JP 2001-41042, assigned to Shin-Caterpillar, the current assignee. Pursuant to assignee's obligations under Rule 56 are there any other Shin-Caterpillar prior art references that the current examiner should be aware of?

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a charge air cooler that pivots around a horizontal axis (as shown in Figures 1-10) or is non-pivotal (as shown in Figures 11-14) and a combined capacitor/oil cooler that pivots around a vertical axis (as shown in Figures 1-10) or a capacitor alone that pivots around a vertical axis (as shown in Figures 10-14), does not reasonably provide enablement for all of the variants claimed in the claims enumerated above. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claims 2-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure supports claims directed to a charge air cooler that pivots around a horizontal axis (as shown in Figures 1-10) or is non-pivotal (as shown in Figures 11-14) and a combined capacitor/oil cooler that pivots around a vertical axis (as shown in Figures 1-10) or a capacitor alone that pivots around a vertical axis (as shown in Figures 10-14) and that is all. The host of constructions being claimed in the claims, to the extent that they go beyond what the original disclosure is directed to, constitute "new matter".

Claims 2-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 are rejected under 35 U.S.C. 112, fourth paragraph, as failing to further limit the subject matter of a previous claim. In claims 2 and 3 and, by extension, all of their dependent claims, applicant attempts to impermissibly redefine what was recited in claim 1. In claim 1, an "air conditioner capacitor" and "another cooling device" as two distinct and different pieces of structure. In both claims 2 and 3, applicant attempts to redefine the "another cooling device" of claim 1 to be "at least, a radiator and the air conditioner capacitor". The "another cooling device" of claim 2 and 3 cannot be the "air conditioner capacitor" because in claim 1 it was claimed as a structure distinct from "another cooling device". A dependent claim cannot contradict the claim from which it depends. See Pfizer v. Ranbaxy, 79 USPQ2d 1583 (Fed. Cir. 2006), invalidating a patent because of a 35 USC 112, fourth paragraph, deficiency.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 3 and, by extension, all of their dependent claims, applicant attempts to impermissibly redefine what was recited in claim 1. In claim 1, an "air conditioner capacitor" and "another cooling device" as two distinct and different pieces of structure. In both claims 2 and 3, applicant attempts to redefine the "another cooling device" of claim 1 to be "at least, a radiator and the air conditioner capacitor". The "another cooling device" of claim 2 and 3 cannot be the "air conditioner capacitor" because in claim 1 it was claimed as a structure distinct from "another cooling device". These limitations found in claims 2 and 3 render them vague, and, by extension, all of their dependent claims as well.

Claim Interpretation:

All claims are construed as directed to a plurality of heat exchangers per se. All functional statements of intended uses of these heat exchangers as capacitors, oil coolers, radiators, turbocharger coolers etc are extended minimal patentable weight in

Art Unit: 3744

the absence of claiming other structure (such a turbocharger connected to the turbocharger cooler etc). Matters of intended use are treated in this manner pursuant to MPEP 2114, incorporated here by reference. A heat exchanger does not undergo a metamorphosis into a new heat exchanger merely by affixing instructions to it that it is intended to cool air coming to it from (an unclaimed) turbocharger.

Rejections:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0952024.

In EP '024 the air conditioner capacitor 6 is mounted to pivot around a vertical axis. The rest of the heat exchangers (2, 3, 4 and 5) do not pivot. A fan deflector guide, 1c, mounted behind the radiator 2 is known by those of ordinary skill in this art to surround a fan that is not shown in the drawings. An oil cooler (3 or 5) is positioned on a side of the radiator opposite the fan. The turbocharger cooler is shown at 4.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0952024 in view of JP 2000-280760.

In EP '024 the air conditioner capacitor 6 is mounted to pivot around a vertical axis. The rest of the heat exchangers (2, 3, 4 and 5) do not pivot. A fan deflector guide, 1c, mounted behind the radiator 2 is known by those of ordinary skill in this art to surround a fan that is not shown in the drawings. An oil cooler (3 or 5) is positioned on a side of the radiator opposite the fan. The turbocharger cooler is shown at 4.

JP '760 teaches mounting an air conditioner capacitor and an oil cooler to one another and both share a common pivot. See Figure 9 of JP '760. To have modified EP '024 by adding an oil cooler mounted to the air conditioning capacitor 6 of EP '024 would have been obvious to one of ordinary skill in the art in view of the teaching of JP '760 for the purpose of advantageously cooling further oil in need of cooling (such as compressor oil or power steering oil, etc.).

Claims 1-3, 5-9, 11-12, 14-15, 17-20, 22-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin Caterpillar JP 2001-41042 in view of JP 2000-280760.

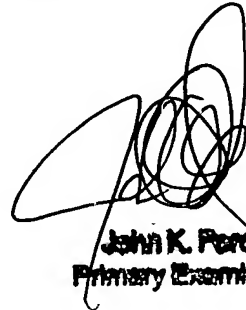
JP 2001-41042, assigned to Shin-Caterpillar, the assignee of the current application, and not disclosed to the examiner by applicant, shows all of the claimed subject matter except for an air conditioning capacitor connected to the pivoting oil cooler 28 of JP '042. To have placed an air conditioning capacitor on the pivoting oil cooler 28 of JP '042 would have been obvious in view of the teaching of JP '760. JP '760 teaches mounting an air conditioner capacitor and an oil cooler to one another and both share a common pivot. See Figure 9 of JP '760. Adding an air conditioner capacitor to the Shin-Caterpillar prior art (JP '042) system would advantageously allow the operator to have air conditioning in the summer and would obviously increase sales of Shin-Caterpillar "work machines" in hot climates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3744

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**John K. Ford**  
Primary Examiner